In the Supreme Court of the United States.

OCTOBER TERM, 1899.

WILLIAM WHEELER HUBBELL, appellant, v. THE UNITED STATES. } No. 96.

APPEAL FROM THE COURT OF CLAIMS.

APPELLEE'S BRIEF.

STATEMENT OF THE CASE.

On December 28, 1878, the appellant filed in the United States Patent Office an application for a patent for an improvement in metallic cartridges, the claims being as follows:

> 1st. The circular plate E, constructed with central solid resisting piece *i*, and two or more side perforations *k*, *k*, substantially as described, applied within a metal case, with cylinder and rear end solid and tight, thereby requiring the insertion of the plate and charge and priming from the front, igniting the charge and remaining fire-tight in firing as described.

2nd. The circular plate E, constructed as described in combination with the circular disc D, and metal solid fire-tight case A, substantially as shown and described.

3rd. A circular metallic tight-fitting plate perforated into a central fulminate chamber, leaving a central solid or unperforated bar over the fulminate chamber, within a solid fire-tight metal case, substantially as set forth. (Rec., 16, 24–25; see figure, Rec., 28.)

The examiners held that all of these claims had been anticipated by prior patents and rejected the application. Thereupon the claimant amended his specification by a more specific description of the precise features of what he alleged to be his invention, and substituted the following as his claim:

In the bottom of a solid metallic flange cartridge case or shell the combination of a circular base enclosing a central chamber of fulminate and an anvil over the fulminate provided with two or more openings whose inner edges nearly coincide with the edges of the central chamber of fulminate in the base of the cartridge, substantially as described. (Rec., 26–27.)

Upon that claim letters patent No. 212313 were granted to him February 18, 1879. (Rec., 16.)

On March 22, 1879, appellant notified the Secretary of War that his patent had been granted, and asked an allowance of royalty on manufactures of the cartridges protected thereby. (Rec., 20.)

From March 1, 1879, to March 31, 1883, the United States manufactured 14,714,082 "cup-anvil" cartridges, and after February 18, 1879, used 2,700,000 of such

cartridges which had previously been made. This type of cartridge is as follows:

The shell is of metal, with a rim around the rear end, which is not perforated. The fulminate is contained in a circular pocket on the rear side of the base of a metal cup which is inserted in the cartridge and rests on the base of the cartridge, being held in place by crimping the walls of the shell over the edge of the cup at its open end. Fire is communicated from the fulminate to the powder by two holes in the bottom of the cup at either end of a diameter of the said pocket, the whole area of these holes being over the fulminate chamber. A portion of the top of the pocket, or bottom of the cup, between the two holes, serves as the anvil to resist the blow of the hammer or firing pin. (Rec., 19.)

From February, 1879, to March 31, 1883, the United States manufactured 3,866,352 cartridges of the following type, viz, a hollow metallic shell, with solid flanged base, and a pocket in the exterior of the center of the base, this pocket being pierced at the center of the top (supposing the cartridge to stand upon its base) by a single aperture to carry the fulminate flame to the powder chamber. This shell, when in use, contains within the powder chamber only the powder and the bullet; a small anvil plate or disk, and a small metal cup containing fulminate being inserted into the pocket, so as to ignite the charge when the cup is struck by the firing pin. The anvil disk has a groove across the upper side, and notches cut out of the disk at each end of this groove, so that when the disk is in place the entire

area of each of these notches is over the fulminate chamber, and the fulminate flame passes through the notches to the groove, and by the groove to the powder chamber through the aperture at the top of the pocket. That portion of the disk which is between the notches serves as the anvil. The complete cartridge, with this type of anvil disk, was known as the "reloading" cartridge. (Rec., 19.)

This type of shell (though with a somewhat different type of primer in the pocket) is shown on Plate LIX in an official publication of the War Department, entitled Ordnance Memoranda, No. 14, published in 1873.

In 1864 the officers of the United States Army began experiments in the manufacture of center-fire cartridges which led up to the adoption of the "cup-anvil" cartridge in 1868, and later the adoption of the "reloading" cartridge above described. (Rec., 18.)

On April 19, 1883, appellant filed a petition in the Court of Claims, alleging, *inter alia*, that the "cup-anvil" and "reloading" cartridges made and used by the United States as stated above were covered by his patent No. 212313, and had been made and used under an implied contract to pay a reasonable royalty therefor. (Rec., 1.) After trial the petition was dismissed June 1, 1885, whereupon the claimant, on August 21, 1885, filed a notice of his application for an appeal to this court, but did not ask for allowance of his application until June 7, 1898, when the appeal was allowed. Prior to the allowance of the appeal, viz, on November 12, 1891, the claimant filed a waiver of all claim on account of the manufacture and use of the cup-anvil cartridge. (Rec., 31.)

BRIEF OF ARGUMENT.

Preliminary remarks in regard to the record.

As the record in this case contains some matter of a character not usually appearing in records transmitted by the Court of Claims, some consideration of this matter, and of how much of it should properly have been included in the record, seems to be necessary.

Pages 12 to 20 of the record contain the eight findings of fact originally filed by the court below on June 1, 1885, when the judgment was rendered. On pages 24 to 27 is what is called an additional finding of fact, viz, a statement that the defendant had requested the court below to find certain facts, admitted by the court below to be shown by the records of the Patent Office, as to the action of the Patent Office upon the appellant's original application for the patent in suit, and as to the changes made by the appellant in his specification and claims in consequence of that action, this statement being accompanied by a statement of the court's refusal to find these facts, for the reason that they "do not constitute such facts as the court is required to find under rule 1 of the Supreme Court relating to appeals from the Court of Claims."

Following this additional finding of fact is the patent in suit (on pages 27 to 29), which had already been printed in full in Finding IV (Rec., 16 to 18), with the drawing, which had not been included in that finding. Why the specification and claims of the patent should be twice spread upon the record does not appear.

Page 30 contains statements of the entry of judgment on June 1, 1885, and of the allowance of the appeal on June 7, 1898.

The lower part of page 30 (beginning with what appears below the marginal figure "36") and pages 31 to 37, down to the certificate, contain matters which (with one exception), it is submitted, should not have been included in the record at all, being wholly irrelevant. They consist of—

(1) A series of motions made by the claimant (the appellant) after the judgment was entered, in regard to amendments of the findings of fact (including briefs of argument upon some of these motions), all of which motions were overruled by the court below. These motions are of the following dates:

August 14, 1885. (Rec., 30.)
April 28, 1896. (Rec., 33.)
May 9, 1896. (Rec., 34–36.)
May 29, 1896. (Rec., 33–44.)

(2) The claimant's application for an appeal. (Rec., 32.) This is of course properly in the record, though it should have preceded the entry of the allowance of the appeal.

(3) Motions to print certain matter for the use of the court below, and in regard to the hearing of arguments in the court below. (Rec., 31, 32–33.) These motions were allowed, but there is no reason why this record should be cumbered with them.

(4) A transcript of certain docket entries in the court below, subsequent to the judgment. These also are wholly irrelevant.

As already stated, the above motions for amendments of findings are irrelevant. It is true that motions of this character, though made after judgment, may be relevant on an appeal, where it appears that the court below was satisfied with the proof of the facts stated in the amendments requested. The rules of this court prescribe the character of the findings that are to be made. Whether the truth of any finding which the court below is requested to make is proved by the evidence adduced in its support has to be determined by the court below in its capacity of a jury; and if it refuses to make the finding because it deems it not to be satisfactorily proved by the evidence, such refusal involves no error in law, and is not the subject of review by this court. It is only when the facts which the court below is requested to find are admitted by it to be proved, but the court below refuses on some legal ground to make the finding, that a statement of the request for a finding and of the refusal can present any legal question for the determination of this court. Finding IX (Rec., 24–27) raises such a question, because the court below states in that finding that the facts which appear in it "*are shown* by the file wrapper and contents in the United States Patent Office in the matter of letters patent No. 212313," and that it refuses to find these facts because it holds "that the file wrapper and contents on an application for a patent do not constitute such facts as the court is required to find under rule 1 of the Supreme Court relating to appeals from the Court of Claims." This raises the distinct question of whether rule 1 does or does not contemplate,

in suits on patents, a finding of the facts shown by the file wrapper and contents.

No legal question, however, is or can be raised by any of the appellant's requests for amendment of findings, because the appellant's right to have such amendments made depends upon the evidence adduced in the court below, at the trial, in support of these amendments, and that evidence can not, under the rules of this court, come before it on appeal. For instance, the motion of May 29, 1896 (Rec., 33, 34), concerns additional findings which were made in another suit between the same parties, which findings the appellant wished to have made in this suit. The propriety of making such findings in this suit necessarily depends upon whether, at the trial of this suit in 1885, the court below had before it the evidence to sustain such findings. If it had not, the mere fact that such evidence was presented in another suit, tried more than ten years later, can not possibly affect the case, and the question of whether the court below, at the trial of this present suit, had before it evidence to sustain the additional or amended findings requested is one which this court can not possibly entertain.

So of the various additional findings requested in the motion of May 9, 1896. (Rec., 34–36.) Their propriety, supposing them to be relevant, depends entirely upon whether the evidence before the court below, at the trial in 1885, warranted such findings; but this is a question into which this court can not enter. As to the various exhibits and models which the court below was requested to make a part of the record, but which it

refused to include therein (Rec., 35, 36), there is nothing to show whether such request was made before the judgment was rendered. If it was not, the refusal of the court below, after judgment, to incorporate into the findings matters which it had not, before judgment, been requested to so incorporate, would not be error, such incorporation after judgment being, if proper at all, wholly discretionary with the court below.

It is therefore submitted that no part of the record between marginal figure "36," on page 30, and marginal figure "49," on page 37, can be considered by this court, except the application for an appeal, on page 32.

The patent in the light of the file wrapper and contents.

It is submitted that patent No. 212313 was granted solely for a cartridge with an anvil plate "provided with two or more openings, whose *inner* edges nearly coincide with the edges of the central chamber of fulminate," a feature not found in the reloading cartridge.

This court has frequently held in suits on patents that the evidence, contained in the file wrapper and contents, of the proceedings of the Patent Office upon the application for a patent, is relevant as showing the precise matter for which the patent was granted. It is true that the correspondence between the applicant for a patent and the Commissioner of Patents or his examiners can not be allowed to enlarge, diminish, or vary the *language* of a patent afterwards issued—that is, it can not have the effect of adding any words to the patent or taking any from it—but when it comes to the *interpretation* of the

language used, the understanding of the applicant and the Patent Office is of some importance as evidence. (*Goodyear Dental Vulcanite Co.* v. *Davis*, 102 U. S., 222, 227.)

This understanding of the parties is especially important where the applicant for a patent for a combination has been compelled by the rejection of his original application to narrow his claim by the introduction of a new element, or of limitations or provisos. In such a case he can not afterwards contend that his patent should be interpreted as if the element so introduced were not an essential feature of the combination, or that the limitations or provisos should not be strictly construed against him. (*Sargent* v. *Hall Safe and Lock Co.*, 114 U. S., 63, 86; *Shepard* v. *Carrigan*, 116 U. S., 593, 597; *Sutter* v. *Robinson*, 119 U. S., 530, 541; *Crawford* v. *Heysinger*, 123 U. S., 589, 607; *Roemer* v. *Peddie*, 132 U. S., 313, 317; *Dobson* v. *Lees*, 137 U. S., 258, 265; *Knapp* v. *Morss*, 150 U. S., 221, 229; *McCarty* v. *Lehigh Valley R. R. Co.*, 160 U. S., 110, 119.)

Similarly, where a claim has been rejected, and such rejection acquiesced in by the applicant, this fact is important as estopping him from contending that the remaining claims, or any of them, should be so construed as to cover the subject-matter of the rejected claim. (*Morgan Envelope Co* v. *Albany Paper Co.*, 152 U. S., 425, 429.)

The differences between the specification and claims of a patent as granted and those upon which the application was made—the abandonment, rejection, or modifica-

tion of claims, and the introduction of limitations or provisos—are disclosed by the file wrapper and contents, and by nothing else. To determine the proper construction to be placed upon the claims of a patent, it is therefore necessary "to consider the *action of the Patent Office* upon the original application of the patentee" (*Knapp* v. *Morss*, 150 U. S. 221, 224), or, in other words, to consider the file wrapper and contents. As is stated in Robinson on Patents, section 1015—

> The principal documentary evidence available in actions for infringement is drawn from the files and records of the Patent Office. * * * The application for the patent and the correspondence of the applicant with the Patent Office in explanation or assertion of his rights may be produced as declarations accompanying an act, and as tending to define the nature of a patented invention, and the relations toward it of the applicant and patentee.

Hence the facts shown by the file wrapper and contents are essentially relevant and material to an issue involving the construction and interpretation of the claims of a patent.

In view of the practice of this court to consider the file wrapper and contents, the court below was asked to make a finding of the facts as to the proceedings in the Patent Office as they appeared in the file wrapper and contents; but the court declined to do so on the ground that the proceedings in the Patent Office "do not constitute such facts as the court is required to find under Rule 1 of the Supreme Court relating to appeals from the Court of Claims." (Rec., 27.) Believing, however, that the court

below was in error on this point, counsel for the appellee requested that court to make an additional finding, stating the facts disclosed by the file wrapper and contents, and that the court had been requested to find them, and had refused. This was accordingly done, as appears from pages 24–27 of the record.

In a later case the Court of Claims took a different view of Rule 1, and has included in its findings the substance of the proceedings in the Patent Office, as evidenced by the file wrapper and contents (*Kelton* v. *United States*, 32 C. Cls. R., 314; see Finding XII, pp. 329–334); so that if the findings in the present case had been made according to the practice followed by the Court of Claims in the Kelton case, a finding as to the proceedings in the Patent Office would have been made in the first instance.

This additional finding raises no question of evidence, nor in any way conflicts with the rule requiring the findings to contain "the facts in the case established by the evidence in the nature of a special verdict, but not the evidence establishing them." The court below has admitted that the facts stated in this finding are actually shown by the evidence (viz, the file wrapper and contents), but has denied that they are "such facts as the court is required to find." This raises the simple question of whether rules of this court require the court below to find such facts when requested, and if this question be (as, it is submitted, it certainly should be) decided in the affirmative, then the court may properly treat the facts, thus brought before it, as if they had been found in the usual way. Moreover, the matters disclosed in the file wrapper and contents in an application for a patent must

have precisely the same materiality and must be admissible in evidence to precisely the same extent in a suit against the United States in the Court of Claims as in a suit between private parties in any other court. The facts shown by the file wrapper and contents will, therefore, be referred to as if they had been originally incorporated in the findings by the court below.

The first point of difference to be noted between the cartridge covered by the appellant's patent and the Government reloading cartridge is that in the former only a very small portion of the openings in the anvil are over the fulminate chamber, while in the latter the openings are wholly over that chamber. As to this it is submitted:

THE RELATIVE POSITION OF THE VENTS AND THE CIRCULAR WALL OF THE FULMINATE CHAMBER IS A MATERIAL PART OF THE APPELLANT'S PATENT—I. E., THESE VENTS MUST BE SO PLACED AS REGARDS THE AXIS OF THE CARTRIDGE THAT ALL BUT A VERY SMALL PORTION OF EACH VENT SHALL BE FARTHER FROM THAT AXIS THAN IS THE CIRCULAR WALL OF THE FULMINATE CHAMBER.

In the appellant's original application of December 28, 1878, the specification (Rec., 24, 25) ended just before the paragraph beginning on the sixth line of page 29 of the record, and the claims were as follows:

> First. The circular plate E, constructed with central solid resisting piece *i*, and two or more perforations *k k*, substantially as described, applied within a metal case, with cylinder and rear end solid and tight, thereby requiring the insertion of the plate and charge and priming from the front, igniting the charge, and remaining fire-tight in firing as described.

Second. The circular plate E, constructed as described, in combination with the circular disk D, and metal solid fire-tight case A, substantially as shown and described.

Third. A circular metallic, tight-fitting plate, perforated into a central fulminate chamber, leaving a central solid or unperforated bar over the fulminate chamber, within a solid fire-tight metal case substantially as set forth.

The examiners rejected these claims; the first and third upon those of Moffatt, 53168, Tibbals, 90607, and English patent 2906 of 1865; and the second on the English patent alone.

Forced to limit his claim to some feature which these prior devices did not contain, the appellant amended his specification by adding the paragraph (Rec., 26) describing the *distinguishing feature* of his invention. The gist of this new descriptive paragraph is contained in the words:

> This [fulminate] chamber at its sides or outer extreme edges communicates directly and exclusively with the powder charge, so that the explosive force of the fulminate is not allowed to expand under a larger area of the anvil plate and blow it out, but is compelled to diffuse its explosive force. * * * To effect this the central anvil piece has no central aperture, is as wide as the fulminate-filled chamber, and the perforations are at the extreme outer side of this fulminate *for two purposes;* one is, to diffuse the fire from this center most thoroughly; the other is, to have an unperforated anvil over and against the fulminate, as it rests solid in its chamber, to receive the central blow of a striker, and obtain complete resistance by the anvil bar, and yet have free escapement for the explosive force, at once from beneath the

anvil plate, without any chamber or space for it to expand into under the plate.

At the same time the appellant struck out all his three original claims and substituted a single claim, as follows (Rec., 26):

> The construction and arrangement of the chamber of fulminate, anvil, plate, perforations, and case, with the central-constructed, filled chamber of fulminate powder in contact and between the base of the case and the circular anvil-plate, with central anvil-bar and two or more side perforations extending from the extreme sides of the chamber of fulminate into the base of the powder charge, whereby the smallest area of resistance is presented to the fulminate explosion, and the fire is diffused in the base of the charge of powder, and the greatest resistance is presented by the front face of the plate to the powder charge, consuming the powder and securing the plate as and by the means described.

The examiners rejected this claim as "vague, indefinite, and ambiguous," but held that the construction shown (shown, that is, in the specification and drawings) *as now understood* (i. e., as explained in the new paragraph of the specification) involved patentable novelty, so that a claim might be allowed, if specific and well defined. (Rec., 26.)

The appellant then further amended the amendment to his specification by inserting the reference to the solid head of the shell, and he substituted the following as the single claim for which a patent was asked:

> In the bottom of a solid metallic-flange cartridge case or shell, the combination of a circular base inclosing a central chamber of fulminate, and an anvil

over the fulminate provided with two or more openings, whose inner edges nearly coincide with the edges of the central chamber of fulminate in the base of the cartridge, substantially as described (Rec., 26–27.)

As so limited and defined the claim was allowed and the patent granted.

It is clear from this comparison of the original specification and claims with the amended specification and the claim ultimately allowed, that whether the appellant be entitled to a broad construction of his claim or not, the claim itself is a very narrow one. The claim is *not* for the circular plate E with solid anvil bar and perforations, applied within a solid-head cartridge shell (first rejected claim), *nor* is it for the plate E constructed as described, in combination with the circular disk D and the solid-head cartridge shell (second rejected claim), *nor* for a circular plate perforated into a central fulminate chamber, leaving a solid anvil bar over the fulminate chamber, within the solid-head cartridge shell (third rejected claim), *nor* for the construction and arrangement of the fulminate chamber, anvil-plate, perforations, and case, as described in the specification, so as to diffuse the fire in the base of the powder charge and consume the powder (first amended claim, rejected). These mechanical combinations are found in the appellant's cartridge, but they are not what constitute its novelty, nor are they covered by the patent. The patent is not granted for a claim for the combination in the bottom of a solid metallic-flanged cartridge case or shell of a circular base inclosing a central chamber of fulminate, and an anvil over the fulminate provided

with two or more openings. Such a claim would not have differed from those that were rejected. The one sole feature of the combination which entitled it to be patented was this, that the anvil plate E had "two or more openings whose *inner* edges nearly coincide with the edges of the central chamber of fulminate in the base of the cartridge."

It was not until the appellant introduced into his specification the new paragraph stating that "The distinguishing feature of my invention is the organized construction. * * * In this organization the fulminate * * * is contracted into a * * * small central chamber and fills it. * * * This chamber at its side or outer extreme edges communicates directly and exclusively with the powder charge. * * * To effect this the central anvil pie e has no central aperture, is as wide as the fulminate-filled chamber, and *the perforations are at the extreme outer sides of this fulminate;*" that the examiners stated that the construction involved patentable novelty, and it was not until the appellant specifically described the combination which he sought to patent as containing the element of an anvil plate with openings placed *in a particular position* with regard to another element (i. e., "openings whose inner edges nearly coincide with the edges of the central chamber of fulminate") that any patent was granted. The court will presume that the examiners acted properly in refusing to allow a patent until the appellant had limited his claim to the particular combination finally described therein, but even if the examiners' views had been incorrect and their

action improper, even if they ought not to have refused the application with the claims as originally worded, the fact remains that the words "whose inner edges nearly coincide with the edges of the central chamber of fulminate," words describing the position of the openings in the anvil plate E, inserted in the claim, after the rejection, are the vital words of the patent, without which, or their equivalent, it would not have been granted, and that no form of cartridge construction to which these words are not applicable can possibly be regarded as covered by the patent. As was said in *Shepard* v. *Carrigan* (116 U. S., 593, 596):

> Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he can not after the issue of his patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. (Citing *Leggett* v. *Avery*, 101 U. S., 256, and other cases.)

The description of the openings in the anvil plate as openings "whose inner edges nearly coincide with the edges of the central chamber of fulminate" is manifestly such a limitation as must prevent the claim from receiving a broad interpretation.

> In patents for combinations of mechanism, limitations and provisos imposed by the inventor, *especially such as were introduced into an application after it had been persistently rejected*, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers. (*Sargent* v. *Hall Safe and Lock Co.*, 114 U. S., 63, 86.)

In the reloading cartridge the whole of the vents are directly over the fulminate chamber, and their outer, not their inner, edges coincide with the edges of the latter. Hence this type of cartridge is clearly outside of the claim in patent No. 212313.

The patent in the light of its own language.

In point of fact, while a reference to the proceedings in the Patent Office is proper and useful, in that it shows, beyond question, that the patent was only granted after the claimant had so restricted his claim as to make the peculiar position of the vents an essential feature of his combination, yet such reference is not really necessary to the correct decision of this case. The language of the specification and the claim is clear enough, without reference to anything outside of them, and it demonstrates two essential differences between the patented cartridge and the reloading cartridge, viz:

(1) The difference in the shape and position of the vents.

(2) The difference in the priming.

The one feature of the Hubbell cartridge which distinguishes it from prior inside-primed cartridges is that the anvil plate has "two or more openings whose *inner* edges nearly coincide with the edges of the central chamber of fulminate." The specification states the purpose of this construction to be two-fold: First, to compel the diffusion of the "explosive force of the fulminate" "into the base of the powder charge," and, second, to leave a solid anvil over the fulminate to resist the blow of the striker. That part of the anvil in the reloading

cartridge which receives the blow of the striker is narrower than the corresponding part of the anvil in Hubbell's cartridge; but the chief difference between the two constructions is that in Hubbell's device only a very small portion of each vent is over the fulminate chamber, their "inner edges nearly coinciding with the edges" of that chamber, their outer parts being over the unperforated part of the disk D, while in the reloading cartridge the vents are wholly over the fulminate chamber, and do not lead directly to the powder chamber, as the Hubbell vents do, but lead to a channel cut across the upper face of the anvil, and by this to a hole in the base of the powder chamber. By this latter construction, while the resisting force of the anvil at its center is not diminished, the explosive force of the fulminate is compelled to enter the powder chamber in a central stream, instead of being compelled to diffuse itself as in the Hubbell device. This diffusion, which is impossible in the reloading cartridge, the appellant considered "the distinguishing feature" of his invention, as the importance attached to it in the specification shows.

Appellant's counsel may seek to belittle this essential difference in the construction of the vents by stating that the powder runs down through the hole in the base of the powder chamber and lies in the groove across the upper face of the anvil. The fact that a few loose grains of powder fall into the groove (or even drop through the notches on to the fulminate) does not affect the operation of the fulminate when exploded. Whatever powder drops through drops loosely, and is not rammed tightly down, as is the powder in the powder chamber. When the ful-

minate is exploded, its flame ignites these loose grains; but as the explosive force of the fulminate is vastly greater than that of a few loose grains of powder, it simply sweeps them along as they ignite, and it enters the powder chamber with practically the same force and in the same way as if these grains had not been in the groove at all. Their effect is too insignificant to be taken note of.

Another essential difference between the two types of cartridge is that the Government's cartridge is outside-primed, the appellant's inside-primed.

The appellant's specification says "open *only* at the front end B, to be primed and loaded at this front opening." So, too, the first claim in the original application for the patent expressly describes the metal case as being made "with cylinder and rear end solid and tight, thereby *requiring* the insertion of the plate and charge and priming from the front." (Rec., 25.) These descriptions make it clear that the cartridge covered by the appellant's patent was necessarily inside-primed, and could not be outside-primed, and hence that in the modification suggested, viz, "the fulminate chamber C may be recessed or formed in the metal of the circular plate E, with central bar *i*, and two side perforations, *k*, *k*, over it, dispensing with the paper," the chamber C is intended to be recessed from the upper side of the base of the cartridge and not from its lower side, as in the Government cartridge. The same intention is manifest from the rest of the specification, for there being no provision for closing the hole that would be left in the base of the cartridge if the fulminate chamber were recessed from the outside, it is clear that such a modification would be inoperative.

The words, "in the bottom," in the claim of the patent, must therefore be understood as limiting the claim to an inside-primed cartridge, while the primer of the Government cartridge "is not in the bottom of the shell" in the sense in which the primer of the appellant's cartridge is, but is in an outside pocket. (Rec., 19.) That this distinction is a substantial one becomes evident when it is reflected that one of the objects for which the Government cartridge is made is that it should be capable of being reloaded. With an outside-primed cartridge, the cup which holds the fulminate is used but once, but the cartridge shell itself is not injured by the blow of the hammer, whereas the base of an inside-primed cartridge is indented by the blow, and must be flattened out before it can be reloaded, while, as this part of the base is very thin, it evidently can not stand many blows. For reloading purposes an outside-primed cartridge is manifestly superior.

The appellant's cartridge must be crimped in order to hold the anvil and the disk D in place, whereas no such crimping is required in the Government cartridge. This is also a substantial difference between the two, because the appellant's cartridge would have to be straightened out and recrimped every time it was reloaded, a fact which would not only make the reloading process much more difficult than with the Government cartridge, but which would also render reloading more than once or twice impossible, owing to the weakening of the metal. The retention of the anvil and disk in the appellant's cartridge by crimping, or some equivalent means, being therefore

indispensable, the words in the claim, "substantially as described," must be understood as including in the claim substantially the method of holding the anvil and disk in place when the cartridge is fired described in the specification, a method which has no equivalent in the Government cartridge.

In this connection it should be remembered that all but a very small feature of the reloading cartridge, as used by the Government, antedates the appellant's application for his patent. The shell of the reloading cartridge existed before 1873 and is shown on Plate LIX of Ordnance Memoranda No. 14, a publication of the War Department, of which the court will presumably take judicial notice. All that distinguishes what is there shown from the reloading cartridge as used by the Government is the primer. The court below has found as a fact that "any one of several different kinds of primers may be used" with the reloading shell (Rec., 19), and it is clear that whatever types of primers were used before 1879 could not have greatly differed from that subsequently used. Certainly the reloading shell, with those primers, constituted a cartridge which had a central chamber of fulminate and also vents over the same, and there must have been enough metal between those vents to constitute "an anvil over the fulminate," as otherwise the cartridge would have been useless, which was not the case. If, therefore, the appellant's patent could be so stretched as to cover the reloading cartridge with the form of primer used in 1879 and subsequently, the patent would have been itself anticipated by the earlier types of reloading cartridge.

The caveat and rejected applications do not help the appellant's case.

It may possibly be contended that the appellant's caveat of 1865 and certain rejected applications for patents for cartridges, all of which are referred to on pp. 12–16 of the record, showed that the appellant had invented, prior to the date of the application for patent No. 212313, a type of cartridge substantially the same as the reloading cartridge, or at least that he had invented a "system" which reached perfection in his patented cartridge. It is submitted that even if this contention were correct it would be wholly irrelevant, because the issue as between the reloading cartridge and that covered by patent No. 212313 is simply whether the two are the same. Unless the reloading cartridge is covered by patent No. 212313, the Government has a right to use the former without regard to who may have invented it.

There is, however, nothing in the record to warrant the contention. In regard to the caveat of April 13, 1865, the court below has found that "no method of communication from the fulminate to the powder was provided, nor any mention made of an anvil." This being so, the caveat can not from any point of view have any bearing on the case whatever.

The application of April 13, 1865, was for a center fire cartridge with hollow flange, the interior of the flange holding the rim of a perforated anvil plate. Not only was this device manifestly different from that shown in the patent No. 212313, but as the application for a patent for the former was rejected, the record fails to indi-

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cate to what extent, if at all, it contained any feature that was a patentable novelty in 1865.

The application of April 25, 1872, was for a cartridge with "a circular metallic anvil, perforated and secured by a bite of the case of the same metal immediately in front of the fulminate." This type of cartridge undoubtedly resembles that for which patent No. 212313 was granted, but the vents or openings through the anvil disk are not confined to any particular position, as they are in the latter type of cartridge. Presumably, it was this failure to indicate the position of the vents which rendered the claim too broad, and necessitated its rejection.

It is to be observed that the petition in the present case alleges that the appellant's successive applications were all for substantially the same invention; but an examination of the applications shows directly the contrary of this, namely, that the rejected applications were all for much broader claims than that allowed in 1879, so that it is clear that the action of the Patent Office has been thoroughly consistent all along.

THE DAMAGES CLAIMED.

In view of what has been said above, it seems superfluous to point out that there was no implied contract in the present case, or to dwell on the fact that no judgment could be based on the manufacture of 9,373,700 primers referred to on page 20 of the record. The record states that they "were manufactured *from* 1883," i. e., after this suit was begun. Moreover, even if the reloading cartridge as a whole was covered by the appellant's patent,

its primer by itself (i. e., the Gill patent anvil and a small cup containing fulminate) was not, for the appellant's patent is for "an organized cartridge." Until the primer was affixed to a cartridge, nothing existed which came within the patent, and there is no *evidence* that any of the 9,373,700 primers referred to were ever so affixed. Besides, the royalty of $1.50 per thousand was computed on the cost of *new* cartridges (5 per cent on $30 per thousand), whereas if an old cartridge is reloaded the cost of the shell must be deducted, and there is no evidence as to this.

For the reasons stated in the previous portion of this brief, it is submitted that the judgment of the court below should be affirmed.

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ADDENDUM.

Since the above was written counsel for the United States have been allowed to see proof sheets of a portion of the appellant's brief. According to these proof sheets, that brief is prepared on the theory that the court will certainly grant the appellant's motion, presented January 8, 1900, for a reargument of case No. 198, of October term, 1897, such reargument to take place along with the argument of the present case. This assumption of what the court will do, as if it were a foregone conclusion—a

matter "cut and dried"—seems hardly consistent with the respect which is due to this court.

As to the assertion that the court below *and the attorneys for the respective parties* seem to have regarded case No. 16261 (in which judgment was affirmed by this court May 31, 1898) as consolidated with the present case, the counsel for the United States deny most emphatically that there is the slightest warrant for such an assertion, except possibly as to what may have been in the mind of the appellant's counsel; and, to judge by their actions, nothing of the sort ever was in their mind until now.

In pursuance of the assumption, referred to above, as to the court's action on the motion just made, the appellant's brief refers to matter which is not in the record of the present case, and also to a part of a deposition taken in the other case. This deposition could not be referred to even on the argument of the appeal in the other case, since the rules of this court regulating appeals from the Court of Claims do not permit any of the testimony to be included in the record, not even depositions of experts in patent cases. The introduction of all matter outside the record is strenuously objected to.

The appellant's brief states repeatedly that in his cartridge the inner edges of the vents "are nearly coincident with the fulminate," and that the construction of the reloading cartridge is the same in this particular. It is hard to see what these words (which are not in the patent) mean, unless it is that these edges are over the fulminate chamber, which is true, and unless some part at least of the vents were over that chamber there could be

no ventage at all. What the patent requires, however, is that the inner edges of the vents should "nearly coincide with THE EDGES of the central chamber of fulminate," a construction not found in the reloading cartridge. That it is not so found constitutes a vital difference between the two types of cartridge. It is too late now to change the language of the patent, especially in the very point which distinguished it from prior inventions and made it possible for the appellant to receive a patent at all.

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